

Remarks/Arguments

Rejection Under 35 USC § 103

The Examiner has rejected claims 1, 3-14 and 25 as being obvious over JP 07-289898 ('898). '898 discloses a catalyst suitable for hydroprocessing which catalyst comprises a group VIA metal, a group VIII iron group metal on a coal or cellulose base organic material. The catalyst may comprise 0.5-30% by weight of a group VIA metal, and 1-50% by weight of a group VIII metal. The Examiner indicates that if both upper limits were to be combined, i.e. 30 wt% and 50 wt%, the total amount of group VI and VIII metal complies with the requirement of claim 1. The Examiner further indicates that higher amounts are contemplated (see [0040]).

However, '898 indicates that amounts larger than the mentioned upper limits may produce a lower activity (see last sentence of [0040]). This would, in contrast to the Examiner's statement, teach the skilled man to use catalysts comprising group VIA and group VIII metals in amounts below the mentioned upper limits. In other words, the skilled man is given hints that teach away from the invention of claim 1. This is supported by the preferred ranges that are given for the amounts of group VI and group VIII metals, i.e. 2-15 wt% and 2-20 wt%, respectively.

Adding up of the upper limits of the preferred ranges of '898 renders a total amount of group VI and VIII metals below the required amount of 70 wt%, calculated as oxide. Furthermore, the Example reveals a catalyst comprising 3 wt% Ni and 8 wt% of Mo (equivalent to 3.8 wt% NiO, and 12.0 wt% MoO₃), which results in a total amount (15.8 wt%) that is not even close to the value required in claim 1.

Even though there is technically an overlap between the possible upper ranges of '898 and the instant claims with regard to the total amount of group VI and VIII metals, patentability is not precluded, since applicant has established that she obtained results

which are unobvious and unexpected, and the instant claims do not read upon a particular embodiment disclosed by '898 (see *Ex parte Thumm*, 132 USPQ 66).

It is further noted that the claimed catalyst further requires the presence of at least two Group VIB metal components. The Japanese reference mentions, but does not exemplify, a composition comprising two Group VIB metal components (nickel-Mo-W) as only one of many combinations of metals possible (i.e. nickel-Mo, nickel-W, Co-Mo, Co-W, nickel-Mo-W, nickel-Co-Mo, Fe-Mo, and Fe-W (see [0038])). The skilled person would have to know to specifically select nickel-Mo-W combination in order to meet the requirement of claim 1. He could make this selection only if he was able to use the present invention as a guide. Such an exercise in hindsight is clearly contrary to the law (see *W.L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303).

Conclusion

In view of the above remarks, it is clear that applicant has convincingly established that the Examiner's rejection of the instant claims based on '898 is in error. Applicant respectfully requests that the instant claims be allowed and issued in due course.

Respectfully submitted



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